

REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 4, 8, 12, 14, 17, 18, 22, 23 and 28 have been amended. No claims have been added or canceled. Thus, claims 1-28 remain pending.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 14-28 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1, 4, 8, 12, 14, 17, 18, 22, 23 and 28 have been amended to more particularly point out and distinctly claim the subject matter of the invention. The amendments made herein are not motivated by the prior art of record. Applicants submit that the amendments to claims 1, 4, 8, 12, 14, 17, 18, 22, 23 and 28 overcome the rejections under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-4, 8-12, 15, 16, 18, 23 and 27 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff (*Wolff*) in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). For at least the reasons set forth below, Applicants submit that claims 1-4, 8-12, 15, 16, 18, 23 and 27 are not rendered obvious by *Wolff* and *Bauer*.

Claim 1 recites the following:

a multifunction machine to supply an electronic document that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

a filter coupled with the multifunction machine to transform the electronic document for publication;

a server coupled to the filter, the server having memory to store the electronic document, the server permitting access to the electronic document using a document identifier and sending, to a publisher-designated location, information regarding the number of accesses to the electronic document that have occurred.

Thus, Applicant claims providing access to electronic documents that have been saved in the absence of an explicit command by a user as part of performing another user specified function, which is also referred to as "unconscious capture" in the specification and some of the claims.

*Wolff* discloses retrieval of electronic documents using URLs via a fax machine. See col. 1, lines 55-63 and col. 3, lines 32-42. *Wolff* does not disclose or suggest the concept of unconscious capture of electronic documents. Therefore, the publication of electronic documents as disclosed by *Wolff* must be significantly different than the publication of unconsciously captured documents as claimed in claim 1.

*Bauer* is cited to teach logging of Web site access statistics. See Office Action at page 3. However, nothing is *Wolff* suggests the desirability of such statistics and *Bauer* does not teach or suggest publication or tracking of unconsciously captured electronic documents. Therefore, no combination of *Wolff* and *Bauer* teaches or suggests the invention as claimed in claim 1.

Claims 2-4 and 8-12 depend from claim 1. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-4 and 8-12 are not rendered obvious by *Wolff* and *Bauer*.

Claim 14 recites the following:

a multifunction machine saving a copy of an electronic document to a server in the absence of an explicit command by a user and in response to another user specified function associated with the electronic document;  
sending a network document identifier and password for accessing the electronic document;  
accessing the electronic document using the network documents identifier and password; and  
sending an electronic message indicating the number of accesses to the electronic document that have occurred.

Claim 16 depends from claim 14.

As mentioned above, *Wolff* does not disclose or suggest the concept of unconscious capture of electronic documents and nothing is *Wolff* suggests the desirability of such statistics. *Bauer* does not teach or suggest publication or tracking of unconsciously captured electronic documents. Therefore, no combination of *Wolff* and *Bauer* teaches or suggests the invention as claimed in claims 14 and 16.

Claim 18 depends from claim 17, which recites:

receiving an electronic document at a server that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

the server allowing access to the electronic document by using a security key and a document resource identifier; and

the server automatically notifying a publisher that an electronic document has been accessed.

Claims 23 and 27 depend from claim 22, which recites:

means for receiving an electronic document at a server that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

means for allowing access to the electronic document by using a security key and a document resource identifier; and

means for automatically notifying a publisher that an electronic document has been accessed.

As mentioned above, *Wolff* does not disclose or suggest the concept of unconscious capture of electronic documents and nothing is *Wolff* suggests the desirability of such statistics. *Bauer* does not teach or suggest publication or tracking of unconsciously captured electronic documents. Therefore, no combination of *Wolff* and *Bauer* teaches or suggests the invention as claimed in claims 23 and 27.

Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff* in view of *Bauer* further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al.

(*Skarbo*). For at least the reasons set forth below, Applicants submit that claims 5-7, 19-21 and 24-26 are not rendered obvious by *Wolff, Bauer* and *Skarbo*.

Claims 5-7 depend from claim 1. Claims 19-21 depend from claim 17. Claims 24-26 depend from claim 22. *Skarbo* is cited to teach conditional deletions of electronic documents. See Office Action at page 6. However, *Skarbo* does cure the deficiencies of *Wolff* and *Bauer* as set forth above. Therefore, whether or not *Skarbo* discloses the elements for which it is cited, no combination of *Wolff, Bauer* and *Skarbo* teaches or suggests the invention as claimed in claims 5-7, 19-21 and 24-26.

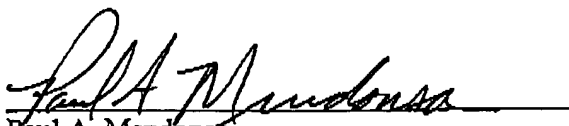
#### Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-28 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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MARKED VERSION OF THE AMENDED CLAIMS

1. (Amended) A system [for publishing an electronic document on a network] comprising:

a multifunction machine to supply [the] an electronic document that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

a filter coupled with the multifunction machine to transform the electronic document for publication;

a server coupled to the filter, the server having memory to store [for storing] the electronic document, the server permitting access to the electronic document using a document identifier and sending, to a publisher-designated location, information regarding the number of accesses to the electronic document that have occurred.

4. (Amended) The system defined in Claim 1 wherein the document identifier comprises a Universal Resource Locator(URL).

8. (Amended) The system defined in Claim 1 wherein the server maintains access logs and updates the access logs each time [a] the electronic document is accessed.

12. (Amended) The system defined in Claim 11 wherein the server manager automatically sends an electronic mail message to the publisher in response to [indicating that] the electronic document [was] being accessed by a user.

14. (Amended) A method [of publishing an electronic document to a user] comprising:  
a multifunction machine saving a copy of [unconsciously sending] an electronic document to a server in the absence of an explicit command by a user and in response to [as part of performing] another user specified function associated with the electronic document;

sending a network document identifier and password for accessing the electronic document;

accessing the electronic document using the network documents identifier and password; and

sending an electronic [mail] message indicating the number of accesses to the electronic document that have occurred.

17. (Amended) A computer-implemented method comprising:  
receiving an [unconsciously captured] electronic document at a server that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

the server allowing access to the electronic document by using a security key and a document resource identifier; and

the server automatically notifying a publisher that an electronic document has been accessed.

18. (Amended) The method defined in Claim 17 wherein the server notifies a user that an electronic mail message containing a Universal Resource Locator(URL) has been sent from a server.

22. (Amended) An apparatus comprising:

means for receiving an [unconsciously captured] electronic document at a server that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

means for allowing access to the electronic document by using a security key and a document resource identifier; and

means for automatically notifying a publisher that an electronic document has been accessed.

23. (Amended) The apparatus defined in Claim 22 wherein means for notifying notifies a user that an electronic-mail message containing a Universal Resource Locator(URL) has been sent from a server.

28. (Amended) An article of manufacture having one or more recordable media having a plurality of executable instructions stored thereon which, when executed by a processing device, cause the processing device to:

receive an [unconsciously captured] electronic document at a server that has been saved in the absence of an explicit command by a user to save the electronic document and in response to another user specified function associated with the electronic document;

allow access to the electronic document by using a security key and a document resource identifier; and

automatically notify a publisher that an electronic document has been accessed.